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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,052

04/11/2006

Robert Helene Ghislain Dirks

2001-1422

8181

466 7590 09/17/2008

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EXAMINER

STAPLES, MARK

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

09/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/563,052</p>	<p>Applicant(s) DIRKS ET AL.</p>	
	<p>Examiner Mark Staples</p>	<p>Art Unit 1637</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 26,29,30,32,35-43 and 48-51.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.

/Young J Kim/
Primary Examiner, Art Unit 1637

Continuation of 13. Other:

The claim amendments filed on 11/26/2007 have been entered.

Applicant's newly presented arguments filed on 07/31/2008 are not persuasive to overcome the prior rejections. The rejection of claims 26, 29, 30, 32, 35-43, and 48-51 under 35 U.S.C. 103(a) as being unpatentable over Powell et al. (1996) and Thomann et al. (2001) is maintained (see Office action mailed on 04/01/2008).

In response to applicant's new argument that the reference of Thomann et al. fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a primer that contains both exon and intron sequence) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that Applicant points to a description, which Applicant refers to as a definition, of an S3P primer in the instant specification but this description fails to exclusively limit an S3P primer to containing both exon and intron sequence. Furthermore, the instant claims recite various constructs of S3P primers.

As no definition is provided in the specification and for discussion which follows, a "splice site" is interpreted to be a point in the sequence of the RNA transcript at which splicing takes place. Splice sites are found at exon and intron boundaries/junctions.

Applicant goes on to argue that Thomann et al. do not teach primers comprising both exon and intron sequences. However in the reply filed on 11/26/2008, Applicant conveys in the 2nd paragraph on p. 16 that "... THOMANN appears to describe primers which either hybridize to the exon or to the intron ...", in other words that the suggestion or appearance of this teaching is at least present in Thomann et al. Examiner maintains the position that Thomann et al. teach primers comprising exon and/or intron sequences. Thoman et al. specifically teach these primers and determining "boundaries [junctions] between exons and introns of a gene" (see p. 2 lines 17 and 18). Thoman et al. also define a boundary as a juncton (see p. 8, 2nd paragraph).

Furthermore, Thomann et al. specifically teach "primer walking" and specifically teach that primers will include the intron boundary which is 5' and 3' ends of introns (see last paragraph on p. 2). Thomann et al. specifically define a boundary as a junction between an exon and non-exon sequence which includes intron sequences (see p. 8, 2nd paragraph). Thus as the primers here include an intron; the primers, by definition of Thomann et al., include an exon-intron boundary sequence. Thus the primers of Thomann et al. comprise exon-intron boundary sequences which are splice-site border sequences, as provided for by the interpretation of "splice-site" as given above. Similarly, Thomann et al. teach "tiled primers" comprising sequences across an entire template and thus necessarily also teach primers comprising exon-intron boundary/junction sequences (see p. 3 lines 11-16). Thomann et al. teach "tiled primers" to "exon-intron boundaries [/junctions]" (see p. 3 lines 11-16 and see claims 1 and 19 for "evenly spaced primers", some of which will include "exon-intron" boundaries").

Thomann et al. go on to teach that the 5' and 3' ends/boundary/junction of introns, which are a splice-site border sequences, will include consensus sequences (see p. 13 lines 12-20). And thus Thomann et al. teach the primers of the claimed invention which comprise at least part of consensus sequences of a splice-site border sequence.

Thus the rejections are maintained.